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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,697	05/19/2005	Detlef Mueller	DE02 0278 US	9252
65913	7590	09/14/2007		
NXP, B.V. NXP INTELLECTUAL PROPERTY DEPARTMENT M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			EXAMINER PARTRIDGE, WILLIAM B	
			ART UNIT 2183	PAPER NUMBER
			NOTIFICATION DATE 09/14/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

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Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/535,697

Applicant(s)

MUELLER, DETLEF

Examiner

William B. Partridge

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 August 2007 **FAILS** TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-8, 10 and 11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed August 29, 2007 have been fully considered but they are not persuasive. Applicant argues in substance:

(1) The drawings are considered not to have any objections.

Examiner respectfully disagrees with Applicant. The drawings are clearly lacking in support for the claimed invention. Nothing aside from an extremely basic block diagram of the system is shown. The drawing itself consists of showing a microcontroller containing only a program counter and a multiplexer and one, what can be assumed to be, data connection between the multiplexer and program counter. There are no inputs or outputs shown on either the program counter or multiplexer other than the assumed data connection. There is no suggestion that the output of the program counter is connected to the multiplexer to enable the reloading of the program counter.

No specific deficiency was pointed out as Examiner felt that they were too numerous to mention. The drawings, as they are, provide no support whatsoever for the claimed invention and are clearly insufficient to anyone of ordinary skill in the art.

The objection to the drawings is maintained.

(2) The claims meet the requirements of 35 USC § 112, second paragraph.

Examiner respectfully disagrees with Applicant. At this time the claims still prove to be unclear. The exact wording of the claims presents that the entire step of either ending the instruction or reloading the program counter with its current address is

optional. This interpretation appears to contradict what was previously presented in the claims and what is in line with the specification, however, the amendments to the claims presented new matter, so it is still unclear.

It appears, based on arguments presented, that Applicant intends the limitation in question to read "is ended immediately, or optionally the at least one program counter..." This would alleviate the issue of clarity in regards to the claims.

The claims as currently presented are still indefinite as it is unclear.

(3) The claims meet the requirements of 35 USC § 112, first paragraph.

Examiner respectfully disagrees with Applicant. The claims are not supported by the specification. Applicant has pointed to page 2, lines 27-29, page 3, line 1, and page 5, lines 3-5 in support for the matter added to the claims.

Page 2, lines 27-29, states that instead of ending the instruction the program counter is re-loaded with it's own value. If anything this provides support that the claims are not supported by the specification as the claims and the specification contradict each other. While the specification states that the instruction is reloaded rather than ended, the claims state that the instruction is reloaded prior to ended.

Page 3, line 1 and page 5, lines 3-5 fail to remedy this issue as well. The previous amendments to the claims are not only not supported by the specification but the specification teaches something to the contrary further proving that the amendments present new matter.

Further, claims 5 now recites that the program counter is reloaded with “at least one of a new/current address or new/current value”. This suggests that the program counter can be loaded or reloaded with multiple values in a given instruction. While only one address or value is required it is presented that there is a potential to do multiple values. There is no support in the specification to support this action.

(4) Cohen does not teach or suggest any feature wherein in case of an unfulfilled branch condition the instruction is optionally either ended or the program counter is reloaded with its current address or current value prior to ending the instruction.

Examiner respectfully disagrees with Applicant. Cohen teaches a jump instruction that can jump to a location in the event a condition is not fulfilled (Page 8, line 41 – page 9, line 29). The address specified could be any address, even that of current program counter or of the next instruction.

(5) Applicant disagrees with the statement that an instruction execution in Cohen would result in a new address being loaded into the program counter.

Examiner respectfully disagrees. While the loading of the address may not be a direct load from memory, in the normal run of execution the program counter needs to be loaded with a new value in order to progress. While the value or address may be directly loaded into the program counter, such as in a branch or jump instruction, a new value or address can also be loaded by a simple increment of the program counter.

While these acts may not be the same in terms of the source of the value a new value is still loaded into the program counter.

(6) Applicant traverses the statement that a microcontroller is inherently a smartcard.

Examiner respectfully disagrees with Applicant. Applicant presented this argument previously in the response to the Non-Final Rejection and Examiner provided support for this argument in the form of Microsoft® Computer Dictionary. See page 15 of the Final Rejection. In order to aid Applicant the support is repeated below.

According to the Microsoft® Computer Dictionary, a smartcard is defines as such: *In computers and electronics, a circuit board with built-in logic or firmware that gives it some kind of independent decision-making ability.* A microcontroller is a circuit board with built-in logic that allows it to execute instructions and thereby make decisions. As such a microcontroller is inherently a smartcard.

(7) Applicant traverses the statement that a special bit is inherently present in the robust jump instruction.

Examiner respectfully disagrees with Applicant. Cohen teaches a new instruction called a robust jump instruction. This instruction is different from a standard jump instruction (Page 8, line 41 – page 9, line 29). As such the instruction must have a different opcode there is at least a bit difference from a standard jump instruction, that

bit being a special bit to indicate that the instruction is a robust jump instruction rather than a standard jump instruction.

(8) Delvaux does not teach or suggest a multiplexer that is controlled to reload the program counter with its current address prior to ending the instruction in the event of an unfulfilled branch condition.

Examiner never relied upon Delvaux for such. Delvaux is relied upon for the use of a multiplexer to control the input to a program counter. The combination of Cohen and Delvaux is relied upon for the above limitation.

(9) Nothing in Cohen or Gammel teaches or suggests testing of the branch condition or the loading of the program counter is carried out with complementary data.

Examiner respectfully disagrees with Applicant. Cohen teaches the loading of a program counter (Page 8, line 41 – page 9, line 29) and Gammel teaches the use of carrying out an operation with the complementary data (Claim 8). The disclosure would have been obvious to one of ordinary skill by Cohen in view of Gammel.

(10) There is no motivation to combine the teachings of Cohen and Gammel.

Examiner respectfully disagrees with Applicant. Further KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a

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finding of obviousness. See the Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20 (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

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